



UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/801,464 02/18/97 FUNAKOSHI A CFD-11946-US

005514 QM32/0605
FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK NY 10112

EXAMINER

DEXTER, C

ART UNIT	PAPER NUMBER
----------	--------------

3724

DATE MAILED:

06/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/801,464

Applicant(s)

Funakoshi et al.

Examiner

Clark F. Dexter

Art Unit

3724



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 27, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above, claim(s) 2, 5, and 13-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, and 6-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Art Unit: 3724

DETAILED ACTION

1. The amendment filed March 27, 2001 has been entered.

Claim Rejections - 35 USC § 112

2. Claims 1, 3, 4 and 6-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 4, 7 and 11, line 3 of each claim, the recitation "like a plane" renders the respective claim indefinite because it is not clear as to what is intended by such a recitation.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 3724

4. Claims 1, 3, 4 and 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gautron, pn 3,398,620.

Gautron discloses a cutting method with every active step of the claimed process including cutting a substrate (e.g., T) having a slice line (e.g., D) and a guide line which is an electrode line/layer (e.g., 13), and detecting a position of the guide line (e.g., with 15, 16) and correcting the cutting position. Gautron only lacks the specific work piece on which the method is performed. However, it would have been obvious to one having ordinary skill in the art to adapt the method of Gautron to gain the benefits taught thereby including a process for accurately cutting along a line in a sheet or otherwise flat piece of material, particularly on a substrate of a thin film semi-conductor device to gain the advantages taught by Gautron.

Regarding claims 3, 8, 9 and 12, Gautron lacks the slice line and guide line being simultaneously formed, lacks an electrode line on the substrate in addition to the electrode layer, and lacks the slice line comprising an electrode line. However, these features appear to be matters of design choice to one having ordinary skill in the art and appear to lack criticality. For example, the slice and guide lines being formed at the same time appears to have no impact to the cutting process or its results. Similarly, the step of forming an electrode line appears to have no impact to the cutting process or its results particularly since the electrode line is not included in any active process steps. Similarly, the slice line comprising an electrode line appears to have no impact to the cutting process or its results particularly since there is no detection of the slice line and further since the slice line is cut away.

Art Unit: 3724

Response to Arguments

5. Applicant's arguments filed March 27, 2001 have been fully considered but they are not persuasive.

In the second paragraph on page 8 of the amendment, applicant argues that Gautron neither teaches nor suggests a method for cutting substrates of a plurality of substrates having two-dimensional thin film elements thereon which substrates are to be arranged adjacently in a plane. The Examiner agrees that such is not explicitly taught by Gautron. However, the Examiner respectfully submits that the claimed material is well known, and it would have been obvious to adapt the known method of Gautron for accurately cutting along a line so as to gain the benefits, particularly the accuracy of the cut, taught by Gautron.

Further, in the paragraph bridging pages 8 and 9 of the amendment, applicant argues that Gautron fails to suggest in any manner the relationship between a slice line and a guide line for an adjacent arrangement of plural substrates in a plane where adjacency of the cut substrates is an important consideration. However, it is respectfully submitted that the particular relationship described between the slice line and the guide line with respect to the substrate(s) is not specifically claimed, and it is believed that Gautron teaches or suggests every step of the method as claimed.

Art Unit: 3724

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Application/Control Number: 08/801,464

Page 6

Art Unit: 3724

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.



Clark F. Dexter
Primary Examiner
Art Unit 3724

cf
June 4, 2001